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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,361	08/28/2003	Junji Kido	2204-031579	7655

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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,361

Applicant(s)

KIDO ET AL.

Examiner

Marie R. Yamnitzky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/844,151.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19, drawn to an organic electroluminescent display device comprising a liquid crystal substance, classified in class 428, subclass 690.
- II. Claim 20, drawn to an organic electroluminescent liquid crystal comprising a carbazole compound, classified in class 548, subclass 440.
- III. Claim 21, drawn to an organic electroluminescent liquid crystal comprising an oxadiazole compound, classified in class 548, subclass 143.
- IV. Claim 22, drawn to an organic electroluminescent liquid crystal comprising a coumarin compound, classified in class 549, subclass 289.
- V. Claim 23, drawn to an organic electroluminescent liquid crystal comprising an aryl compound having alkyl and alkoxy substituents, classified in class 568, subclass 626.
- VI. Claim 24, drawn to an organic electroluminescent liquid crystal comprising an amine compound, classified in class 564, subclass 434.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Groups II-VI are related as combination and subcombinations. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombinations

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as claimed because none of the device claims requires any of the compounds of the liquid crystal claims. The subcombinations have separate utility such as in a liquid crystal device that is not also an electroluminescent display device.

Inventions of Groups II-VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Groups II-VI have separate utility in/as liquid crystal compositions for devices that are not electroluminescent display devices. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the searches required for the different Groups are not coextensive, restriction for examination purposes as indicated is proper. For example, each of Groups II-VI requires a different search since the compounds defined in the five independent claims drawn to an electroluminescent liquid crystal are patentably distinct compounds and have different classifications, and it is not necessary to determine the patentability of any of Groups II-VI in order to determine the patentability of Group I since Group I does not require the electroluminescent liquid crystal of any of Groups II-VI.

A telephone call was made to Russell Orkin on September 29, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

During the September 29th telephonic conversation, the possibility of adding a device claim requiring an organic electroluminescent liquid crystal comprising a compound selected from the possibilities set forth in present claims 20-24 was discussed. Such a claim would link Group I with Groups II-VI. If such as a claim is presented in response to this restriction requirement, an election of species is also required since the claim would be generic to a plurality of disclosed patentably distinct species comprising a chemical compound represented by one of the five general constitutional formulae in present claims 20-24. If such a claim is presented, applicant is required under 35 U.S.C. 121 to elect a single disclosed species (i.e. a chemical compound represented by one of the five formulae), even though this requirement is traversed. The elected species will be used as the starting point for search and examination purposes.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax number for all official faxes is (571) 273-8300. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

MRY
September 29, 2005



MARIE YAMNITZKY
PRIMARY EXAMINER

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